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Wilfried Blum

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EXAMINER

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/798,311	Applicant(s) BLUM ET AL.	
	Examiner PAUL FISHER	Art Unit 3689	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-7,9-20,28,29,31-34 and 36-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-7, 9-20, 28-29, 31-34 and 36-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 June 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Request for Continued Examination submitted on December 2, 2010 has been acknowledged. Claims 3, 8, 21-27, 30 and 35 have been canceled. Claim 43 has been added. Claims 1-2, 4-7, 9-20, 28-29, 31-34 and 36-43 are currently pending and have been considered below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on December 2, 2010 has been entered.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-2, 4-7, 9-20, and 38-41 are rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. Based upon consideration of all of the relevant factors with respect to the claims as a whole, claims 1-2, 4-7, 9-20, and 38-41 are held

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to claim an abstract idea, and are therefore rejected as ineligible subject matter under 35 U.S.C. 101. The rationale for this finding is explained below:

Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to an examiner is that one clue to patent eligibility under 35 USC 101 is whether or not the process is (1) be tied to a particular machine or apparatus or (2) transforms underlying subject matter (such as an article or materials) to a different state or thing. *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

The claim should recite the particular machine or apparatus to which it is tied, for example by identifying the machine or apparatus that accomplishes the method steps, or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally insufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Here, applicant's method steps fail the first prong of the new test because while the claims recite that the method is embodied on a computer network, it is unclear if all of the steps are being performed on the network or if the network itself is merely being used as a means of data gathering or data transfer. Currently none of the limitations of the claimed limitations require a particular machine to carry out any of the significant steps. For example the automatically routing does not state that a computer or the network routes the information. Further the limitations found in the now amended system claims are not found specifically "analyzing means adapted to analyze", currently there is no mention of a machine analyzing the data in the method claims. Claim 41, states that "analyzing a content" takes place but does not say who or what is performing this task. Further other significant steps such as "determining a disposition", "modifying" and "sorting" as stated in claim 1 are not tied to a machine. The steps which are receiving and sending appear to use the network but are considered to be merely data transmission and as such are considered insignificant extra solution activity. The step of displaying is also considered extra solution activity and are not central to the invention itself. Currently these steps can be performed by a person and do not require a machine to perform them. The claims do not pass the first test of Bilski with respect to providing a tie to a particular machine.

Further, applicant's method steps fail the second prong of the test because the claimed steps do not result in an article being transformed from one state to another. There is no transformation occurring in the claims for a physical object or substance or data that represents physical objects or substances.

The claims as recited are directed toward the abstract idea of evaluating parts. As shown above there is not a significant tie to a particular machine to show that the involvement of the network constitutes a practical application of this concept. Particularly the steps of modifying, determining and sorting are not clearly tied to a particular machine. The rest of the limitations appear to be data being displayed or transferred from one point to another, where the bulk of the invention can be performed by a person, and where the person then merely transfers their results to another person through the network, using the network as a means for communication not as device performing the steps of evaluating the parts. Therefore as stated above the machines which are recited are merely for insignificant steps and as such do not render the claim patent eligible under 35 USC 101.

Dependent claim(s) 2, 4-7, 9-20, and 38-40 when analyzed as a whole are held to be patent ineligible under 35 U.S.C. 101 because the additional recited limitation(s) fail(s) to establish that the claim(s) is/are not directed to an abstract idea, for the same reasoning as set forth with respect to claim 1. The dependent claims do not act to remedy the problem with claim 1 by reciting (explicitly or implied) the use of any particular machine and/or any significant transformation.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1, 2, 4-7, 9-20, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Amir M. Hormozi: "Parts Remanufacturing in the Automotive Industry" (First Quarter 1997) hereafter Hormozi, further in view of Bell (5,497,235) hereafter Bell, further in view of Schick et al. (US 2002/0065698 A1) hereafter Schick.

As per claim 1, Joao discloses a method embodied on a computer network for remotely evaluating a vehicular part (Page 1, paragraph 9; discloses that the invention pertains to vehicle maintenance, and that information is shared. Page 2, paragraph 15; discloses that there is a central point in which the different parties communicate through and that one of the parties are vehicle parts providers) comprising:

receiving, from a vehicular dealer, description information regarding said vehicular part in an electronic folder (Page 21, paragraph 281; discloses that the information is gathered about state of disrepair, further it states that this information can be obtained from a vehicular dealer);

sending, from a central server, said electronic folder including said description information to an assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an

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assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center);

modifying, at a terminal at said assessment center, the electronic folder to include a grade for the vehicular part, the electronic folder once modified corresponding to an updated electronic folder (as best understood by the Examiner a grade is equivalent to an assessment of a part based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading...") (Page 20, paragraph 275; discloses that the user of the system can be any of the parties which include vehicle service providers any of these parties can enter information or modify the electronic folder. Page 21, paragraph 285; discloses that a user of the system can modify the document to include an assessment or information regarding the vehicles malfunction problems. Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers and this is done through their respective computer, from this it is clearly shown that the assessment center enters data regarding the vehicle and its parts at any time during the process and this entry is done from a terminal at the assessment center);

receiving from said assessment center, the updated electronic folder (Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well);

sending said updated electronic folder from said central server to said vehicle dealer (Page 3, paragraph 39; discloses that the apparatus can send or output repair reports to the vehicle dealer; Page 10, paragraph 157; discloses that the vehicle dealer computer is in communication with the central processing computer or central server);

displaying said grade, at said vehicular dealer (Page 15, paragraph 213; discloses output devices the could be used by the system, which includes a display for displaying the information. Page 15, paragraph 214; discloses that the information stored in the system can be made available to any of the users of the system which include the vehicular dealer, from this it is obvious that the information is displayed);

automatically transmitting to an Original Equipment Manufacturer (OEM) a notification of the disposition (Page 5, paragraph [0060]; discloses that notifications can be sent to the Manufacturer automatically);

Joao fails to fully disclose determining a disposition of said vehicular part based on said grade of said assessment and at a remanufacturer, sorting the vehicular part according to the grade.

Hormozi, which talks about parts remanufacturing in the automotive industry, teaches determining whether said vehicular part how a part maybe disposed based on said assessment or grade (Page 26, paragraphs 1 and 2; teach that there are different strategies in saving customers money and address the concerns of different constituencies, some of them include recycling and remanufacturing, as discussed above since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade. Page 1,

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paragraph 4; teaches that the process of remanufactured products includes inspection to determine if the product is capable of being remanufactured parts are too badly worn are replaced. This inspection is an assessment of the part itself to determine if it needs to be replaced or is capable of being salvaged).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of recycling or remanufacturing as taught by Hormozi, to accomplish the required services for the customer for less. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled.

The combination of Joao and Hormozi, fail to explicitly disclose sorting the vehicular part according to the grade.

Bell, which talks about inspecting and grading products or parts, teaches it is known to sort products based on grade (Abstract, Col. 3, lines 56-63; teaches that products or parts are graded and sorted and this is done to reduce waste, by grading to determine whether a product maybe downgraded, reworked, or sold as a lower quality product, this concept is similar to the one shown in Hormozi which shows a remanufacturer determining if a product can be reworked or remanufactured for the same reason shown in Bell for the purpose of saving money and reducing waste, by

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sorting the parts as done in Bell the process is more efficient and it is easier to determine which products can be remanufactured and which products need to be scrapped. While Hormozi fails to explicitly disclose this process it would have been obvious that since parts need to be tracked and inspected it would have been obvious to sort the parts into parts that can be remanufactured and those which can't).

Therefore, from this teaching of Bell, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by the combination of Joao and Hormozi, with the use of sorting graded parts as taught by Bell, to reduce waste and to determine which parts that can be downgraded, reworked or remanufactured as taught by Bell. By sorting the parts as done in Bell the process is more efficient and it is easier to determine which products can be remanufactured and which products need to be scrapped. While Hormozi fails to explicitly disclose this process it would have been obvious that since parts need to be tracked and inspected it would have been obvious to sort the parts into parts that can be remanufactured and those which can't.

The combination of Joao, Hormozi and Bell fails to explicitly disclose said description information including information relating to a type of said vehicular part and where the routing is based on the information relating to the type of said vehicular part.

Schick, which like Joao talks about a system and method for managing assets, teaches that description information includes information relating to the type of part and that the information is routed based on the information relating to the type of part (Page 1, paragraph [0006], Page 2, paragraph [0021], Page 7, paragraph [0057]; teaches that

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the information is evaluated to determine the most logical repair location based on various information including part information and a notification is set either by e-mail message or by providing information on a central web page to the service team detailing the parts and labor necessary for a timely and accurate repair. From this it would have been obvious to one having ordinary skill in the art at the time of the invention to automatically send or route the information to the specific party upon evaluation of the information to ensure that the necessary parties are provided the required information in a timely manner. By sending or routing the information directly to the required parties the information is guaranteed to reach them and would eliminate the requirement to check the central site, thus achieving the goal stated in Schick of distributing the information at a time when it can be used most effectively by people responsible for the assets).

Therefore, from this teaching of Schick, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by the combination of Joao, Hormozi, and Bell, with the distribution of the information based on the parts as taught by Schick, for the purpose of effectively and efficiently distributing the information regarding the assets to the people who are the most logical to repair or have the most knowledge of those parts as taught by Schick. By sending or routing the information directly to the required parties the information is guaranteed to reach them and would eliminate the requirement to check the central site, thus achieving the goal stated in Schick of distributing the information at a time when it can be used most effectively by people responsible for the assets.

As per claim 2, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 4, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses comprising at least one of the steps of mining data and generating reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 5, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses wherein said data and reports are compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 6, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses that warranty information is handled by the system and that the payment information would also be handled by the system (Page 22, paragraph 290; discloses that information will be sent to the warranty

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providers and that this information will effect who is responsible for paying for the repair).

Joao fails to explicitly disclose wherein said disposition of said vehicular part comprises at least one of discarding the vehicular part and a warranty settlement for said vehicular part based on said assessment.

While Joao fails to fully disclose the idea of a settlement, it would have been obvious to one of ordinary skill in the art at the time of the invention include a settlement during the process of determining who is responsible for paying for the repairs. For example if the user's engine seizes during normal operation they would call up the warranty provider to determine if the damage was covered by their warranty. At which point the warranty provider would issue a disposition or final judgment if the user is to be awarded a settlement and the damage is covered by the user's warranty.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include settlements being awarded to the user of the vehicle provided by Joao, for the purpose of ensuring that the user gets compensated for their damage to their vehicle, if it is covered by the warranty.

As per claim 7 the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 9, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses comprising at least one of the steps of mining data and generating reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 10, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses wherein said data and reports are in such a format as to be compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 11, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses that the system is used to facilitate the process of repairing parts or performing services associated with those parts (Page 22, paragraph 290; discloses the central server takes in information that will help in the repair process for parts and services). Joao also discloses that many facilities can access the system (Page 22, paragraph 299; discloses that multiple parties can access the system in regard to repair and servicing of parts, these parties include intermediary or third party sites).

Joao fails to explicitly disclose sending said vehicular part to a third party for at least one of repair and recycling.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches sending vehicular parts to a third party and that services provided by the third party include repair and recycling (Page 26, paragraphs 2 and 6; teach that there are five services that can be performed two of which are repair and recycling, and that 90% of sales come from independent channels such as third parties. Page 26, paragraph 8; teaches that companies like Ford motor company have often relied on third party sites to repair and remanufacture items since they did not have the resources, from this it would be obvious that in the case of repair and recycling of parts third parties would be used if the facilities such as the dealer does not have the resources on site to complete the task. Also it would have been obvious that since these third party sites are not located on site they would have to have the parts sent to them).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of sending third parties parts for repair or recycling taught by Hormozi, to accomplish the required services for the customer. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled. Since the system is dealing with third parties or companies that are not onsite the parts that have to be services would have to be sent to them in order for them to be repaired or recycled.

As per claim 12, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses providing an assessment based on vehicular parts (Page 22, paragraph 289; discloses that the different services providers can provide a diagnosis or an assessment regarding the state of disrepair of the part).

Joao fails to explicitly disclose comprising at least one of identifying and ordering missing materials required for a remanufacturing of said vehicular part based on said assessment.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches comprising at least one of identifying and ordering missing materials required for remanufacturing of said vehicular part based on said assessment (Page 29, paragraphs 5 and 6 under Bills of Materials; teaches that each remanufactured parts have pieces associated with them that have to be identified, ordered and then replaced).

As per claim 13, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention; Joao fails to fully disclose comprising the automatically ordering said materials required for remanufacturing of said vehicular part.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches comprising the automated ordering of said materials required for remanufacturing of said vehicular part (Page 29, paragraphs 5 and 6 under Bills of Materials; teaches that each remanufactured parts have pieces associated with them that have to be identified, ordered and then replaced and that these pieces are ordered automatically if it is guaranteed that those parts will be replaced, as stated with a RF

rating of 1.00, which states that every time the person in going to remanufacture that part, that piece is going to have to be replaced every time).

As per claim 14, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses that original equipment manufacturers have intermediaries or third parties handle things (Page 2, paragraph 21; discloses that intermediaries can act on behalf of the vehicle manufactures which are the OEM or original equipment manufacturers. Page 22, paragraph 299; discloses that these intermediaries can access the system at any time. Page 21, paragraph 281; discloses that the first location can be the vehicle manufacturer and/or intermediaries).

Joao fails to explicitly disclose where the representative or intermediary is authorized.

Hormozi, which talks about remanufacturing parts in the automotive industry, teaches that representatives of the original equipment manufacturer are authorized (Page 26, paragraph 8; teaches that Ford used outside companies as intermediaries for the exchanged of parts and services and those intermediaries were authorized representatives).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of authorized intermediaries or third parties taught by Hormozi, for the purpose of ensuring the quality of work to their customers. If the third party did not have a high standard of work it would reflect poorly upon the original equipment manufacturer so by authorizing these companies shows the

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customer that these facilities are up to pair with the original equipment manufacturer. Also as stated in the article this deal benefits the OEM because in some cases these they don't have the infrastructure or the resources to take on such a service so these third parties offer a reliable alternative.

As per claim 15, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses wherein assessment center comprises at least one of an independent assessing center, an original equipment manufacturer, and a warranty processing center (Page 22, paragraph 290; discloses that the assessment can be any one of an independent assessing center or repair shop, equipment manufacturers, warranty providers as well as others).

As per claim 16, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses comprising the step of providing access to a party at a third location to said assessment (Page 22, paragraph 299; discloses that access is granted to multiple parties at any point and those parties include intermediaries or third parties. These parties can access the system to view the assessment and to add information).

As per claim 17, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses wherein said party at said third location accesses said assessment through an Internet web browser (Page 11, paragraph 168; discloses that the invention functions on the Internet and can be accessed using a web site which accessing would have to include the use of a web browser).

As per claim 18, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses wherein said party at said third location comprises an original equipment manufacturer (Page 22, paragraph 299; discloses that at any time another party can access the system which includes the vehicle manufacturer or the original equipment manufacturer).

As per claim 19, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses comprising producing data and reports for a plurality of vehicular parts and their assessment (Page 22, paragraph 289; discloses that the reports will include whatever plurality of parts will be necessary to affect the repairs).

As per claim 20, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses comprising providing said data and reports in such a format as to be compatible with internal data management systems of a party receiving said data and reports (Page 22, paragraph 299; discloses that any of the users of the system can access and use the information that is stored on the central server which is acting as the internal data management system, since all parties can access and add information all of that information has to be compatible).

As per claim 38, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, Joao further discloses comprising selecting an assessment center based on the description information (Page 22, paragraph 296; discloses based on the description information the user can selected an assessment center or any of the service or parts providers).

7. **Claims 28, 29, 31, 32, 36 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Schick et al. (US 2002/0065698 A1) hereafter Schick.**

As per claim 28, Joao discloses a data center used in a remote evaluation of a vehicular part (Figure 1; discloses a central processing computer or server which takes in data from various other locations for the evaluation of vehicle parts), said data center comprising:

a computer server adapted to communicate remotely with a vehicular dealer and one or more assessment centers (Figure 1; discloses that the central processing computer or server communicates with other computers across the network, this would include the vehicle dealer computer character 40 and the vehicle service provider computer or the assessment center. Further the central processing computer could also communicate with any of the computers connected to the network), said computer server comprising:

input means adapted to receive, from said vehicular dealer, said electronic folder including said description information regarding said condition of said vehicular part in an electronic folder (Page 21, paragraph 283; discloses that the user enters information that is to be sent to the central server via a computer. Page 12, paragraph 173; discloses various input devices to enter information into the system);

output means adapted to route said description information to said appropriate assessment center (Page 15, paragraph 213; discloses output devices the could be used by the system); and

said input means adapted to receive, from a terminal of said appropriate assessment center, a grade for the vehicular part, said electronic folder having been modified at said terminal of said appropriate assessment center to include said (Page 22, paragraph 293; discloses the user being sent the report or assessment. Page 12, paragraph 173; discloses various input devices to enter information into the system. Page 20, paragraph 275; discloses that the user of the system can be any of the parties which include vehicle service providers any of these parties can enter information or modify the electronic folder. Page 21, paragraph 285; discloses that a user of the system can modify the document to include an assessment or information regarding the vehicles malfunction problems. Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers and this is done through their respective computer, from this it is clearly shown that the assessment center enters data regarding the vehicle and its parts at any time during the process and this entry is done from a terminal at the assessment center and that the system includes an input means for receiving this information).

said output means adapted to route said electronic folder, once modified to include said grade, to the vehicular dealer, where the grade will be used to determine the disposition of the vehicular part and, said output means being also adapted to route the electronic folder to a remanufacturer where the grade will be used for sorting the vehicular part (Page 15, paragraph 213; discloses output devices that could be used by the system, who gets sent the data is considered intended use of the system claim, further what gets sent is considered to be merely a title given to the data. What the data

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is then used for its again intended use, these limitations fail to impart new structural limitations on the claim and therefore do not serve to distinguish the claimed invention from the prior art, the adapted to language is not a positive limitation but rather indicated that the system has to be capable of performing the task, since the system contains the means to route information it is adapted to route information to any party thus it is capable of performing these tasks).

Joao, fails to explicitly disclose analyzing means adapted to analyze a content of said electronic folder and to determine an appropriate assessment center based on a type of said vehicular part.

Schick, which like Joao talks about a system and method for managing assets, teaches that description information includes information relating to the type of part and that the information analyzed to evaluated then it is routed based on the information relating to the type of part (Page 1, paragraph [0006], Page 2, paragraph [0021], Page 7, paragraph [0057]; teaches that the information is evaluated to determined the most logical repair location based on various information including part information and a notification is set either by e-mail message or by providing information on a central web page to the service team detailing the parts and labor necessary for a timely and accurate repair. From this it would have been obvious to one having ordinary skill in the art at the time of the invention to automatically send or route the information to the specific party upon evaluation of the information to ensure that the necessary parties are provided the required information in a timely manner. By sending or routing the information directly to the required parties the information is guaranteed to reach them

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and would eliminate the requirement to check the central site, thus achieving the goal stated in Schick of distributing the information at a time when it can be used most effectively by people responsible for the assets).

Therefore, from this teaching of Schick, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the distribution of the information based on the parts as taught by Schick, for the purpose of effectively and efficiently distributing the information regarding the assets to the people who are the most logical to repair or have the most knowledge of those parts as taught by Schick. By sending or routing the information directly to the required parties the information is guaranteed to reach them and would eliminate the requirement to check the central site, thus achieving the goal stated in Schick of distributing the information at a time when it can be used most effectively by people responsible for the assets.

As per claim 29, the combination of Joao and Schick teaches the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page13, paragraph 185).

As per claim 31, the combination of Joao and Schick teaches the above-enclosed invention, Joao further discloses comprising a server database for storing at least a portion of said description information in said electronic folder (Page 15,

paragraph 206; discloses that the system includes a database that will be used to store all of the information).

As per claim 32, the combination of Joao and Schick teaches the above-enclosed invention, Joao further discloses wherein said computer server is further adapted to communicate with a third location and said output means further sends said assessment to said third location (Page 22, paragraph 299; discloses that various parties can access the system, and these parties include intermediaries, these parties can obtain information and input information).

As per claim 36, the combination of Joao and Schick teaches the above-enclosed invention, Joao further comprising a server database for storing at least a portion of said description information in said electronic folder (Page 15, paragraph 206; discloses that the system includes a database that will be used to store all of the information).

As per claim 43, Joao discloses a system for a remote evaluation of a vehicular part over a communication network (Figure 1; discloses a central processing computer or server which takes in data from various other locations for the evaluation of vehicle parts), said system comprising:

a central server (Figure 1; discloses that the central processing computer or server communicates with other computers across the network, this would include the vehicle dealer computer character 40 and the vehicle service provider computer or the assessment center. Further the central processing computer could also communicate with any of the computers connected to the network);

a first terminal at a vehicular dealer, said first terminal being in a remote communication with said central server, and being adapted to create and send to said central server an electronic folder including description information regarding said vehicular part (Page 21, paragraph 281; discloses that the information is gathered about state of disrepair, further it states that this information can be obtained from a vehicular dealer. Figure 1; discloses a first terminal at a vehicle dealer, which is in remote communication with the central server);

a second terminal at one or more assessment centers, said second terminal being in a remote communication with said central server, and being adapted to receive said electronic folder, and update a content of said electronic folder to indicate a grade of said vehicular part (Page 20, paragraph 275; discloses that the user of the system can be any of the parties which include vehicle service providers any of these parties can enter information or modify the electronic folder. From this it is shown that the folder or information is updated. Page 21, paragraph 285; discloses that a user of the system can modify the document to include an assessment or information regarding the vehicles malfunction problems. Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers and this is done through their respective computer, from this it is clearly shown that the assessment center enters data regarding the vehicle and its parts at any time during the process and this entry is done from a terminal at the assessment center);

a third terminal at a remanufacturer, said third terminal being in a remote communication with said central server, and being adapted to receive said electronic folder and output a selected content of said electronic folder (Page 15, paragraph 213; discloses output devices that could be used by the system, who gets sent the data is considered intended use of the system claim, further what gets sent is considered to be merely a title given to the data. Figure 1; discloses various terminals where the information can be received, where the terminal is located is considered to be merely a title since no remanufacturer has taken place. At this point it is merely a terminal receiving information. What the data is then used for is again intended use, these limitations fail to impart new structural limitations on the claim and therefore do not serve to distinguish the claimed invention from the prior art, the adapted to language is not a positive limitation but rather indicated that the system has to be capable of performing the task, since the system contains the means to receive and output the information it is adapted to receive and output the information to any party thus it is capable of performing these tasks);

Joao fails to explicitly disclose wherein the central server is adapted to analyze the content of the electronic folder received from the first terminal, select an appropriate assessment center based on a type of the vehicular part, route said electronic folder to said appropriate assessment center, and, upon receipt of the updated electronic folder from said appropriate assessment center, route the updated electronic folder to said first terminal and said third terminal for determining a disposition of said vehicular part.

Schick, which like Joao talks about a system and method for managing assets, teaches that description information includes information relating to the type of part and that the information analyzed to evaluated then it is routed based on the information relating to the type of part (Page 1, paragraph [0006], Page 2, paragraph [0021], Page 7, paragraph [0057]; teaches that the information is evaluated to determined the most logical repair location based on various information including part information and a notification is set either by e-mail message or by providing information on a central web page to the service team detailing the parts and labor necessary for a timely and accurate repair. Page 7, paragraphs [0051] and [0056]; teaches that the customers can obtain real-time status updates from various portals, for the purposes of keeping updated of the status of the equipment. From this it would have been obvious to one having ordinary skill in the art at the time of the invention to automatically send or route the information to the specific party upon evaluation of the information to ensure that the necessary parties are provided the required information in a timely manner. And to send or route information to the concerning parties as the information is updated to keep all parties informed of the status. By sending or routing the information directly to the required parties the information is guaranteed to reach them and would eliminate the requirement to check the central site, thus achieving the goal stated in Schick of distributing the information at a time when it can be used most effectively by people responsible for the assets).

Therefore, from this teaching of Schick, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part

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servicing system provided by Joao, with the distribution of the information based on the parts as taught by Schick, for the purpose of effectively and efficiently distributing the information regarding the assets to the people who are the most logical to repair or have the most knowledge of those parts as taught by Schick. By sending or routing the information directly to the required parties the information is guaranteed to reach them and would eliminate the requirement to check the central site, thus achieving the goal stated in Schick of distributing the information at a time when it can be used most effectively by people responsible for the assets.

8. **Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Amir M. Hormozi: “Parts Remanufacturing in the Automotive Industry” (First Quarter 1997) hereafter Hormozi, further in view of Schick et al. (US 2002/0065698 A1) hereafter Schick .**

As per claim 41, Joao discloses a method embodied on a computer network for remotely evaluating a vehicular part (Page 1, paragraph 9; discloses that the invention pertains to vehicle maintenance, and that information is shared. Page 2, paragraph 15; discloses that there is a central point in which the different parties communicate through and that one of the parties are vehicle parts providers), comprising:

inputting, at a vehicular dealer, description information regarding the vehicular part in an electronic folder (Page 21, paragraph 281; discloses that the information is gathered about state of disrepair, further it states that this information can be obtained from a vehicular dealer);

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sending the electronic folder including the description information to the assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center);

receiving the electronic folder at the assessment center (Page 22, paragraph 293; discloses that the central processing computer or central server transmits or sends the diagnostic report and/or repair, maintenance, and/or servicing report to the user's computer, Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment center, from this it is shown that a central server sends an electronic folder including description information to an assessment center. Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, from this it is shown that the various users receive the information that was sent);

at a terminal at the assessment center modifying the electronic folder to include a grade for the vehicular part (as best understood by the Examiner a grade is equivalent to an assessment of a part based on the applicant's specification page 9, paragraph [0034] which states "...the folder is then returned to the dealer along with the assessment or grading...") (Page 22, paragraph 297; discloses that the service provider or repair facility which is considered the assessment center can transmit back to the central server updated or modified information including the assessment of the vehicle and or part. Since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well. Page 20, paragraph 275; discloses that the user of the system can be any of the parties which include vehicle service providers any of these parties can enter information or modify the electronic folder. Page 21, paragraph 285; discloses that a user of the system can modify the document to include an assessment or information regarding the vehicles malfunction problems. Page 22, paragraph 299; discloses that at any time during the process any user can add additional information this includes vehicle service providers and this is done through their respective computer, from this it is clearly shown that the assessment center enters data regarding the vehicle and its parts at any time during the process and this entry is done from a terminal at the assessment center);

receiving the electronic folder at the vehicular dealer (Page 22, paragraph 293; discloses that the user can receive the diagnostic report. Page 21, paragraph 282; discloses that a user can consist in any number of people including vehicle service providers and vehicle insurance providers which are equivalent to an assessment

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center, from this it is shown that a central server sends an electronic folder including description information to an assessment center).

displaying at the vehicular dealer, said grade (Page 15, paragraph 213; discloses output devices the could be used by the system, which includes a display for displaying the information. Page 15, paragraph 214; discloses that the information stored in the system can be made available to any of the users of the system which include the vehicular dealer, from this it is obvious that the information is displayed);

outputting said grade at the vehicular dealer (Page 3, paragraph 39; discloses that the apparatus can send or output repair reports or assessments to the vehicle dealer; Page 10, paragraph 157; discloses that the vehicle dealer computer is in communication with the central processing computer or central server); and

automatically transmitting to an Original Equipment Manufacturer (OEM) a notification of the disposition (Page 5, paragraph [0060]; discloses that notifications can be sent to the Manufacturer automatically);

Joao fails to fully disclose determining whether said vehicular part may be recycled or disposed based on said assessment.

Hormozi, which talks about parts remanufacturing in the automotive industry, teaches disposing of the vehicular based on said assessment (Page 26, paragraphs 1 and 2; teach that there are different strategies in saving customers money and address the concerns of different constituencies, some of them include recycling and remanufacturing, as discussed above since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is

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based on grade. Page 1, paragraph 4; teaches that the process of remanufactured products includes inspection to determine if the product is capable of being remanufactured parts are too badly worn are replaced. This inspection is an assessment of the part itself to determine if it needs to be replaced or is capable of being salvaged).

From this teaching of Hormozi, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by Joao, with the use of recycling taught by Hormozi, to accomplish the required services for the customer for less. As mentioned in Hormozi many dealers or manufacturers don't have the resources to take on such a task as repairing parts or recycling them and often these parts were just replaced with brand new ones. Hormozi shows that the process of disposing of parts that could be salvaged is wasteful and also costs more money and energy then having those parts repaired or recycled.

The combination of Joao and Hormozi, fails to explicitly disclose analyzing a content of said electronic folder and selecting an assessment center based on a type of the vehicular part.

Schick, which like Joao talks about a system and method for managing assets, teaches that description information includes information relating to the type of part and that the information evaluated or analyzed and then routed based on the information relating to the type of part (Page 1, paragraph [0006], Page 2, paragraph [0021], Page 7, paragraph [0057]; teaches that the information is evaluated to determined the most logical repair location based on various information including part information and a

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notification is set either by e-mail message or by providing information on a central web page to the service team detailing the parts and labor necessary for a timely and accurate repair. From this it would have been obvious to one having ordinary skill in the art at the time of the invention to automatically send or route the information to the specific party upon evaluation of the information to ensure that the necessary parties are provided the required information in a timely manner. By sending or routing the information directly to the required parties the information is guaranteed to reach them and would eliminate the requirement to check the central site, thus achieving the goal stated in Schick of distributing the information at a time when it can be used most effectively by people responsible for the assets).

Therefore, from this teaching of Schick, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the part servicing system provided by the combination of Joao and Hormozi, with the distribution of the information based on the parts as taught by Schick, for the purpose of effectively and efficiently distributing the information regarding the assets to the people who are the most logical to repair or have the most knowledge of those parts as taught by Schick. By sending or routing the information directly to the required parties the information is guaranteed to reach them and would eliminate the requirement to check the central site, thus achieving the goal stated in Schick of distributing the information at a time when it can be used most effectively by people responsible for the assets.

9. **Claims 33, 34, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), further in view of Schick et al. (US 2002/0065698 A1) hereafter Schick.**

As per claim 33, the combination of Joao and Schick teaches the above-enclosed invention, Joao further discloses that warranty information is handled by the system and that the payment information would also be handled by the system (Page 22, paragraph 290; discloses that information will be sent to the warranty providers and that this information will effect who is responsible for paying for the repair).

Joao fails to explicitly disclose wherein the computer server is adapted to determine the disposition based on said grade, and wherein the output means outputs the disposition, the disposition comprising at least one of a discarding of the vehicle part and a warranty settlement for said vehicular.

While Joao fails to fully disclose the idea of a settlement, it would have been obvious to one of ordinary skill in the art at the time of the invention include a settlement during the process of determining who is responsible for paying for the repairs. For example if the user's engine seizes during normal operation they would call up the warranty provider to determine if the damage was covered by their warranty. At which point the warranty provider would issue a disposition or final judgment if the user is to be awarded a settlement and the damage is covered by the user's warranty. As discussed above since the grade is equivalent to the assessment then the Examiner asserts that a grade is shown as well, and therefore the disposition is based on grade.

Further the grade could be as simple as pass or fail, for example the part is broken or not, and thus the settlement would be based on if the part needs to be replaced.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to include settlements being awarded to the user of the vehicle provided by the combination of Joao and Schick, for the purpose of ensuring that the user gets compensated for their damage to their vehicle, if it is covered by the warranty.

As per claim 34, the combination of Joao and Schick teaches the above-enclosed invention; Joao further discloses wherein said description information comprises at least one of textual data, binary data, scanned documents, digital images, digital audio and video of said vehicular parts (Page 21, paragraph 286, Page 12, paragraph 177, Page 13, paragraph 185).

As per claim 37, the combination of Joao and Schick teaches the above-enclosed invention, Joao further discloses wherein said computer server is further adapted to communicate with a third location and said output means further sends said assessment to said third location (Page 22, paragraph 299; discloses that various parties can access the system, and these parties include intermediaries, these parties can obtain information and input information).

10. **Claim 39 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Hormozi, further in view of Bell (5,497,235) hereafter Bell, in view of Schick et al. (US 2002/0065698 A1) hereafter Schick as**

applied to claim 1 above, further in view of Williams et al. (US 2002/0032573 A1) hereafter Williams.

As per claim 39, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, but fails to explicitly disclose printing a shipping label based on a destination identified in the determining of a disposition.

Williams, which talks about an apparatus, systems and methods for online, multi-parcel, multi-carrier, multi-service enterprise parcel shipping management, teaches printing a shipping label identifying a destination (Page 27, paragraphs [0447]-[0449]; teaches that a shipping label can be printed by the user of the system identifying a destination as well as package information details).

Therefore, from this teaching of Williams, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by the combination of Joao, Hormozi, Bell and Schick with the printing of shipping labels that provide destination information as taught by Williams for the purpose of expediting shipping to customers as well as to service providers. By printing the labels from the stored data the user is ensured that the information is up to date and correct, which limits the room for error.

11. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Hormozi, further in view of Bell (5,497,235) hereafter Bell, in view of Schick et al. (US 2002/0065698 A1) hereafter Schick as applied to claim 1 above, further in view of Untiedt et al. (7,216,096) hereafter Untiedt.

As per claim 40, the combination Joao, Hormozi, Bell and Schick teaches the above-enclosed invention, but fails to explicitly disclose adding an event-driven status indicator to the electronic folder for tracking the progress of a claim concerning the vehicular part.

Untiedt, which talks about an integrated inventory management system, teaches having an event-driven status indicator for tracking the progress of a vehicular part (Col. 2, lines 23-26, Col. 6, lines 3-36; teach that upon an event happening such as a dealer agreeing or disagreeing to supply a part the information regarding that customer request is updated with the current status in this case if the part was back ordered or not).

Therefore, from this teaching of Untiedt, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by the combination of Joao, Hormozi, Bell and Schick with the use of status indicators as taught by Untiedt for the purpose of keeping track of client requests and ensuring that the service is fulfilled. By including a status indicator the system is aware if the order has been fulfilled or not and this helps avoid possibly forgetting a service request or trying to fulfill a service request that has already been fulfilled.

12. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over Joao (US2002/0016655A1), in view of Schick et al. (US 2002/0065698 A1) hereafter Schick, further in view of Park et al. (US 2001/0039594 A1) hereafter Park.

As per claim 42, the combination of Joao and Schick teaches the above-enclosed invention, Joao further discloses a central processing computer or central

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server (Figure 1, character 10; discloses that the system contains a central processing computer or central server), but fails to explicitly disclose comprising validating means (server) for validating contents of said assessment based on a set of pre-defined rules.

Park, which talks about a method for enforcing workflow processes for website development and maintenance, teaches comprising validating means (server) for validating contents of said assessment based on a set of pre-defined rules (Figure 1; teaches that the system includes a server. Page 5, paragraph [0058]; teaches that server includes software that validates user-entered data based on a set of predetermined rules, from this it would have been obvious given that Joao includes a website as shown page 11, paragraph [0168], to include on the server the software to validate user entered data on that website based on predetermined rules as taught by Park to ensure that the information is correct before proceeding).

Therefore, from this teaching of Park, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method for evaluating vehicular parts provided by the combination of Joao and Schick with the use of data validation based on rules as taught by Park, for the purpose of ensuring the data is complete and correct before proceeding. Since both Park and Joao show websites that include data entry it would have been obvious that the central server shown in Joao could be programmed to validate the information submitted by the users based on a set of predetermined rules as taught by Park.

Response to Arguments

13. Applicant's arguments filed December 2, 2010 have been fully considered but they are not persuasive.

14. In response to the applicant's arguments regarding the 101 rejections, specifically that, "Machine-Or-Transformation Test is Not The Sole Test For Patentability," while the Examiner agrees that the "Machine-Or-Transformation" test is not the sole test it does provide a good indication as to if the subject matter is patent eligible under 35 U.S.C. § 101. As stated above in the 101 rejection the claims as currently written do not require that the significant steps of the invention are performed by any machine. While this is not the only test it does provide evidence that the claims themselves are not drawn to patent eligible subject matter. As stated above there is not a significant tie to a particular machine to show that the involvement of the network constitutes a practical application of the concept of evaluating parts. That is to say a person can evaluate the parts and make their determination mentally and use the computer network merely as a tool to transfer the data to another point. Thus, since there appears to be no practical application of the concept of evaluating parts the concept itself appears to be merely an abstract idea which can be performed mentally. As such the claims fail to recite matter which is patent eligible under 35 U.S.C. § 101.

15. In response to the applicant's argument regarding the 101 rejections, specifically that, "The Claims Recite Patent-Eligible Subject Matter because they are not Directed to an Excluded Class," the Examiner respectfully disagrees. As stated above the claims do

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not recite practical application of the concept of evaluating parts, and as such the limitations can be largely performed mentally and using the network merely to transfer the results of those mental processes.

16. In response to the applicant's argument that the "method for remotely evaluating a vehicular part which may only be implemented using a computer network," the Examiner respectfully disagrees. As stated above while the preamble recites a computer network it is unclear which steps specifically are being performed by the network. Further it appears from the limitations of the claims as currently written that limitations can be largely performed mentally and using the network merely to transfer the results of those mental processes. As such the network appears to be more of a tool of transferring information rather than a particular machine carrying out significant steps. Since the claim lacks any recitation of machine conducting the steps of evaluating, and only appear to be transferring the data after it is has been evaluated by a human the ties appear to be insignificant and as such are deemed not to be patent eligible subject matter under 35 U.S.C. § 101.

17. In response to the applicant's argument that, "the claimed invention cannot be implemented without the computer network which includes a central server and terminals at the dealer and the assessment center. The computer network recited in the claims is not an extrasolution activity nor a field-of-use but an important element without which the claims do not function," the Examiner respectfully disagrees. The network itself is not claimed to be performing any of the significant steps, the network appears to

be merely transferring data, as stated above this sort of tie is deemed to be insignificant and as such are deemed not to be patent eligible subject matter under 35 U.S.C. § 101.

18. In response to the applicant's argument that, "the method is not limited to gathering and outputting. In particular, the electronic folder requires machines for sending, receiving, interpreting, updating and outputting the content thereof. Claims 2 and 7 recite that the content includes audio and video files, and digital images. Inherently, this type of files may only be interpreted by machines," the Examiner respectfully disagrees. This sort of data is often interpreted by humans viewing, or listing to the files. There currently is not recitation that requires a machine to interpret, or update these files rather the claims merely state that these files are interpreted and updated which can be done by a person. As stated above the claims as currently written appear to largely performed mentally and using the network merely to transfer the results of those mental processes and the network itself is not claimed to be performing any of the significant steps, the network appears to be merely transferring data, as stated above this sort of tie is deemed to be insignificant and as such are deemed not to be patent eligible subject matter under 35 U.S.C. § 101. Therefore for the reasons stated above the rejections have been maintained.

19. In response to applicant's argument that Bell is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, while

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Bell may not be inspecting the same parts, it is however solving the same problem which is inspecting and grading products or parts, and teaches it is known to sort products based on grade. Since the reference is pertinent to the same problem it is considered to be analogous art. As such the rejections have been maintained.

20. Applicant's arguments with respect to claims 1-2, 4-7, 9-20, 28-29, 31-34 and 36-43, specifically the arguments directed to the new claim limitations, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL FISHER whose telephone number is (571)270-5097. The examiner can normally be reached on Mon/Fri [8am/4:30pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/P. R. F./
Examiner, Art Unit 3689
/Dennis Ruhl/
Primary Examiner, Art Unit 3689